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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,733	02/09/2004	Nobumasa Sasa	KOY-18	9205
20311	7590	08/17/2006		
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER SELLERS, ROBERT E				
ART UNIT			PAPER NUMBER	
1712				

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,733

Applicant(s)

SASA, NOBUMASA

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The informalities cited in the non-Final rejection mailed April 27, 2006 on page 4, paragraph 4 have been resolved by the amendment filed July 27, 2006.
2. The obviousness-type double patenting rejection over copending application no. 10/826,059 has been overcome by the terminal disclaimer filed July 27, 2006.
3. The 35 U.S.C. 102 rejections over Laksin et al. Patent No. 6,727,295; Frings et al. Patent No. 6,770,686; Crivello Patent No. 4,319,974; the Journal of Polymer Science: Part A: Polymer Chemistry article by Crivello et al., Japanese Patent No. 2002-47474, CAPLUS accession no. 1998:808928, PCT Publication No. WO 96/21702, Sullivan et al. Publication No. 2004/00225025; Misev Patent No. 6,235,807; Schulthess et al. Patent No. 5,783,358; Hatton et al. Patent No. 2004/0106769 and Shimoda et al. Publication No. 2004/0059085 as well as the 35 U.S.C. 102(b) rejection over European Patent No. 118,748 are rescinded. The insertion of the limitations of claim 2 defining an epoxy compound of general formula (1) into independent claim 1 is not recited by the aforementioned prior art.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 118,748 and Takai Publication No. 2004/0242839.

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Claims 10 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to the claims hereinabove, and further in view of Yatake Patent No. 7,030,174; Oka et al. Publication No. 2002/0020832 and Shirakawa et al. Publication No. 2001/0045178.

The rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed July 27, 2006 have been considered but are unpersuasive. Both the European patent (page 5, Formula I, R_1 , R_9 , R_{10} and R_{18} ; page 7, Formula II, R^1 , R^9 , R^{10} and R^{18} ; and page 8, Formula III, R_1' , R_9' , R_3'' and R_4'') and Takai (page 3, paragraphs 37 and 38, Formula (I), R^1 , R^9 , R^{10} and R^{18}) depict cycloaliphatic diepoxides conforming to claimed general formula (1) wherein the aforementioned R groups at the α - or β - positions include hydrocarbon moieties.

4. The mere fact that these substituents are not exemplified does not discount the express illustration of their presence in the European patent and Takai. It would have been obvious to employ the cycloaliphatic diepoxides of the European patent and Takai with hydrocarbon substituents at the α - or β - positions in order to regulate the reactivity of the oxirane groups.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712